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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,094

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Jeannie Holmes

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05/24/2006

EXAMINER

NUTTER, NATHAN M

IP Department
Patton Boggs, LLP
2001 Ross Avenue
Suite 3000
Dallas, TX 75201

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,094

Applicant(s)

HOLMES ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 03-06.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the arguments filed 7 April 2006, the following is being placed in effect.

The rejection of claims 1, 2, 4, 5, 10, 11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Oka et al (WO 03/020817), is hereby expressly withdrawn.

The rejection of claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya et al (US 5,981,610), is hereby expressly withdrawn.

The rejection of claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Merguriya (US 6,506,331), is hereby expressly withdrawn.

The objection to the disclosure because of the informalities that the term *ethynyl cyclohexanol* throughout the Specification and claims is misspelled, is hereby expressly withdrawn.

Claim Interpretations

The recitations in the broad claims embrace constituents that are known to be employed together in various combinations. The recitations of the several ingredients of the formulations of the dependent claims 7-9 and 16-18, due to the number of required constituents, necessarily would not be found within the confines of a single reference. At paragraph [0025], the Specification discloses the "toasted oak dust" as "sometimes used by wineries to enhance the flavor of wine," and that "(w)hen added to the silicone-based compound...gives the resulting product a mottled, speckled, or non-uniform

appearance that closely resembles natural cork.” Since the “toasted oak dust” is disclosed as being for appearance, it will be viewed as a filler chosen for this aspect. Further, the Specification discloses at paragraph [0025] that “*untoasted* oak dust could also be used to obtain *similar results* (emphasis added).” The employment of the pigment is disclosed for aesthetic coloration. The employment of ethynyl cyclohexanol as a platinum catalyst inhibitor (as a regulator) in the silicone resin composition is disclosed at paragraph [0027]. The employment of silicon hydride is disclosed as being “added to insure that the catalyzing reaction works properly,” is assumed to be regarded that it is employed as a platinum catalyst coordinating compound, as is known in the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) or Merguriya (US 6,506,331), each as applied to claims rejected above, and further in view of Descamps et al (US 5,162,397), Strauss (US 4,031,059) and Snogren (US 3,296,153) all taken together.

The reference to Oka et al (WO 03/020817) teaches the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated

and herein claimed. Paragraphs [008] through [0010] show the resin (including claims 2 and 11). The fumed silica is included at paragraph [0011]. The use of cross-linking agents include an organic peroxide (claims 5 and 14) at paragraph [0013] and chloroplatanic acid (claims 4 and 13) at paragraph [0017]. Those citations teach the amounts claimed for each compositional limitation, as embraced by the reference.

The patent to Merguriya et al (US 5,981,610) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (lines 19 et seq.) for the resin. Note the paragraph bridging column 3 to column 4 for the use of fumed silica as a known thixotropic agent. Note column 4 (lines 17-22) for the use of chloroplatanic acid, as recited in claim 4. The use of a hollow filler is shown at column 4 (lines 27-48). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

The patent to Merguriya (US 6,506,331) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (line 51) to column 3 (line 34) for the resin. Note column 5 (lines 1-16) for the use of fumed silica as a filler. Note column 4 (lines 34-52) for the use of chloroplatanic acid, as recited in claim 4, and (lines 53-64) for the peroxide component. The use of a hollow filler is shown at column 5 (lines 17-

64). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

The references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) each show the broad composition of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed.

The reference to Oka et al (WO 03/020817) also teaches the use of the pigments at paragraph [0027] and 1-ethynyl-cyclohexanol, used as a curing inhibitor, at paragraph [0028] as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya et al (US 5,981,610) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 5, bridging column 8 to column 9. At column 5 (lines 1-16) the reference teaches the use of carbon black, zinc white, known colorants. Both features as recited in instant claims 8, 9, 17 and 18

The reference to Merguriya (US 6,506,331) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 1, column 7, and the use of carbon black and zinc white at column 5 (lines 1-16).

The reference to Descamps et al (US 5,162,397) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 2 (lines 30 et seq.), a cross-linking agent of chloroplatanic acid at column 10 (lines 9 and 10) with a silica filler at column 7 (lines 9-16) and a microsphere agent, including the borosilicates of claims 3, 7-9, 12 and 16-18. Note column 1 (lines 50-66)

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and column 10 (lines 15-24 and 43-63) for the borosilicates and their compositional limitations. The reference teaches the conventionality of using a platinum catalyst inhibitor, such as an acetylenic alcohol (ethynyl cyclohexanol is one) at column 4 (lines 1-25). Carbon black may be included at column 7 (lines 8-16).

The reference to Strauss (US 4,031,059) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 13 (line 31) to column 14 (line 12), with hollow microspheres at column 14 (lines 36 et seq.), a curing agent and a silica filler. Note the Examples. The reference teaches the inclusion of ground cork at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26). The reference is clear as to why ground cork, microspheres and other low density fillers are employed, and deemed essentially equivalent, at column 2 (lines 11-20) and column 4 (lines 59 et seq.) as having a "lower thermal conductivity and higher specific heat."

The reference to Snogren (US 3,296,153) teaches the manufacture of a resin filled composition that may comprise a polysiloxane with a curing agent. The reference further teaches at column 7 (lines 23-66) and Table III, the use of "granulated cork, charred granulated cork" and "small hollow micro spheres," which may be glass or ceramic materials and may comprise the borosilicates of the instant claims and silica as suitable filler materials. Note the many Examples.

The primary references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) all show the broad composition as conventional to include a methyl vinyl silicone polymer, including

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polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. The secondary references are relied upon to show the conventionality of each of the various constituents recited in claims 3, 6-9, 12 and 16-18, including the borosilicate microspheres, the toasted oak dust ("charred granulated cork"), pigment, silicon hydride and ethynyl cyclohexanol in silicone resins, including those recited and claimed herein. Since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success. The manipulation of the compositional limitations, depending on availability of materials, anticipated physical characteristics and cost procedures for the manufacture would clearly be within the purview of an artisan skilled in this art. The primary references teach such levels of inclusion. As such, the instant claims would have been obvious to a practitioner in the art in view of the references cited, absent any showing of unexpected results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren (US 3,296,153) and Oka et al (WO 03/020817), both cited and for the reasons set out above.

The patent application to Akbar et al (SN 10/685,052) teaches essentially the identical composition, except fails to show a filler of fumed silica or microcapsules, or the addition of oak dust. These features are shown to be conventional by Snogren (US 3,296,153) and Oka et al (WO 03/020817) and would have been known at the time the Akbar invention was made.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments filed 7 April 2006 have been fully considered but they are not persuasive.

Regarding the Interview of 9 March 2006, it has not been established that the references cited do not "contain mention of oak dust," as alleged. The references to both Strauss and Snodgren show "charred oak dust" as a suitable filler material in composites of the type herein claimed. Applicants have not shown satisfactorily "that 'oak dust' as defined in the specification is the oak dust associated with the wine-making industry, which necessarily excludes dust made from natural cork." The Declarations do

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not address any issue regarding the inclusion of the oak dust in compositions as recited herein. The Declaration to Holmes is not relevant since it is drawn to speculation made by observers as "most people that view these stoppers believe the stoppers more closely resemble natural cork stoppers than other synthetic stoppers currently in use," is tantamount to hearsay evidence, and has no basis in science. Further, the Declaration to Tiberia is, likewise, irrelevant since it does not address issues related to the instant claims regarding patentability. The Declaration expounds known facts about cork, but do not show, teach, explain or elucidate why the cork would be excluded. A term is interpreted for its breadth, not in derogation of its known meaning, as herein attempted. Nothing is recited in the claims to exclude the cork employed by either Strauss or Snodgren. Further, it is not clear to this Examiner why applicants insist that the use of oak dust in the composition claimed would present effects any more or less deleterious to the wine bottled with cork over the conventional cork stopper. Applicants may define terms as their own lexicographers, but the term cannot be defined in derogation of its known and accepted meaning, as attempted herein. Oak is oak regardless of how applicants choose to limit their definition.

With regard to the rejection of the claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Oka et al, Merguriya et al ('610) or Merguriya ('331), and further in view of Descamps et al, Strauss and Snogren, all of these references are drawn to composites, just as herein claimed. Applicants are reminded that the rejection was made under 35 USC 103 and not under 35 USC 102. The instant claims are drawn to a composition, not to an object or article, as argued. The references do not have to

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recognize each and every feature that applicants prefer, desire or even show in their composition. The inclusion of such would infer the characteristics of each component to the mixture. Applicants argue the rejection was made using non-analogous art, as though each reference must teach the use of their composites, and that such use include a bottle stopper. The claims are drawn to filled silicone polymers. The references each show aspects that are included. The references are each drawn to silicone compositions, variously filled with the constituents herein claimed. Again, the rejection is made under 35 USC 103, not under 35 USC 102, as argued.

Regarding the rejection under the judicially-created doctrine of obviousness-type double patenting, no timely filed Terminal Disclaimer has been received. The reference to Snodgren shows the inclusion of the oak dust.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

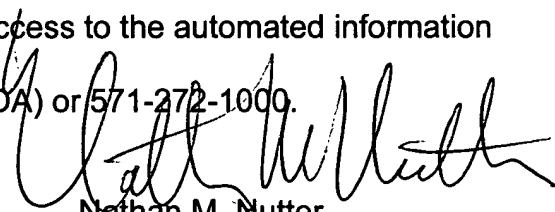
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

22 May 2006